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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 09/719,559   | 03/02/2001  | Reinhard Plaschka    | JEK/PILASCHKA        | 3460             |
| 7590   | 01/13/2006  |                      | EXAMINER             |                  |
| Bacon & Thomas<br>4th Floor<br>625 Slaters Lane<br>Alexandria, VA 23124-1176 |             |                      | FERGUSON, LAWRENCE D |                  |
|  |             |                      | ART UNIT             | PAPER NUMBER     |
|  |             |                      | 1774                 |                  |

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/719,559             | PLASCHKA ET AL.     |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Lawrence D. Ferguson   | 1774                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 18,19,21-34 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 18,19,21-34 and 46 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed October 12, 2005.

Claim 46 was amended rendering claims 18-19, 21-34 and 46 pending.

***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 18-19, 21-23, 25, 27-29 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418).

Chiang discloses an ID card having a security pattern (column 4, lines 15-35) with a paper support that can be plastic (column 4, lines 45-62) having a polymeric security layer comprising acrylate material (column 5, lines 5-15 and column 6, lines 7-15) which protects the paper layer. Chiang further discloses the visible colored pattern or design can be fluorescent pigment that becomes visible when examined under ultra violet light or machine-readable pattern (column 8, lines 1-10). The printed indicia can be applied onto the polymeric layer using printing ink (column 6, lines 57-62). Chiang discloses

laminating the image surface of the print with a plastic overlay (column 5, lines 18-25) which is interpreted as an outer lacquer layer. Chiang does not explicitly disclose a coating weight as in instant claim 19. However, such coating weight is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the coating weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. coating weight) fails to render claims patentable in the absence of unexpected results. The coating weight is optimizable as it directly affects the durability and flexibility of the security paper. It would have been obvious to one of ordinary skill in the art to make the security paper with the limitations of the coating weight since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Chiang does not explicitly disclose the coating is dirt repellent.

Mueller teaches a paper with a dirt repellent protective coating disposed on the surface of the paper layer (column 5, line 57 through column 6, line 25). It would have been obvious to one of ordinary skill in the art to have employed the dirt repellent protective layer, as taught in Mueller, on the paper substrate of Chiang to reduce frictional resistance without affecting the surface of the paper (column 6, lines 26-41) and extending the life and usability of the paper.

***Claim Rejections – 35 USC § 103(a)***

4. Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Manser et al. (U.S. 5,525,400).

Chiang and Mueller are relied upon for instant claim 18 as above. Chiang does not disclose the paper being unsized. Manser teaches an ID card (column 1, lines 5-10) where the paper is sized or unsized and may contain various fibers (column 3, lines 8-10) where the adhesive portion comprises acrylates or methacrylates (column 4, lines 5-19). Chiang and Manser are both directed to ID cards having acrylate adhesive material. It would have been obvious to one of ordinary skill in the art for the paper of Chiang to be unsized so the security paper can be used in a variety of shaped ID cards for more versatility and utility.

***Claim Rejections – 35 USC § 103(a)***

5. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of Mueller (U.S. 6,107,418) further in view of Takeuchi et al. (U.S. 4,856,857).

Chiang and Mueller are relied upon for instant claim 18 as above. Chiang does not disclose the paper having cotton fibers. Takeuchi teaches an ID card having an adhesive layer comprising polymethacrylic material (column 14, lines 9-24) having a paper support comprising cotton fiber (column 19, lines 11-35). Chiang and Takeuchi are

both directed to ID cards having acrylate adhesive layers. It would have been obvious to one of ordinary skill in the art to include cotton fiber in the substrate of Chiang to improve the texture of the ID card.

***Claim Rejections – 35 USC § 103(a)***

6. Claim 29-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaule (U.S. 5,817,205) in view of Chiang et al. (U.S. 5,380,695).

Kaule teaches making a security paper (column 3, lines 44-45 and column 6, lines 13-36) by applying a coat to the paper surface (column 5, lines 1-3) along with lacquers and printed protective layers (column 5, lines 59-65). Kaule teaches the paper comprising paper fibers (column 7, line 67) where the surface is suitable for producing isolated coated areas (column 8, lines 29-31). The reference discloses a paper machine cutting the paper to a desired size (column 9, lines 11-24). The coating of Kaule lacks both polyurethane and a filler substance. Although Kaule does not explicitly disclose a dirt repellent surface, it would have been obvious to one of ordinary skill in the art that the coating of Kaule repels dirt because the coating is provided with lacquers and printed protective layers (column 5, lines 59-65) which helps keep the security paper free from dirt. Kaule does not specifically disclose the coating layer comprising acrylates. Chiang discloses an ID card security paper having a security pattern (column 4, lines 15-35) with a paper support (column 4, lines 45-62) having a polymeric security layer comprising acrylate material (column 5, lines 5-15 and column 6, lines 7-15) which protects the paper layer. Kaule and Chiang are analogous art because they are from the

same field of security documents. It would have been obvious to one of ordinary skill in the art to include acrylates in the security document of Kaule because the acrylate material improves the binding properties and durability of the coating layer.

***Response to Arguments***

7. Arguments made in regards to rejection made under 35 USC 102(b) and 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of WO 2004/072378 (WO378) are moot based on grounds of new rejection. Arguments made in regards to rejection made under 35 USC 102(b) and 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of WO 2004/072378 (WO378) further in view of Manser et al. (U.S. 5,525,400) are moot based on grounds of new rejection. Arguments made in regards to rejection made under 35 USC 102(b) and 35 USC 103(a) as being unpatentable over Chiang et al. (U.S. 5,380,695) in view of WO 2004/072378 (WO378) further in view of Takeuchi et al. (U.S. 4,856,857) are moot based on grounds of new rejection.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Kaule (U.S. 5,817,205) in view of Chiang et al. (U.S. 5,380,695) have been considered but are unpersuasive. Applicant argues Kaule does not describe protective coatings that include an acrylate system as the sole binder and lacking a filler substance. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although Kaule does not specifically disclose the coating layer comprising acrylates, Chiang teaches an ID card security paper having a security pattern (column 4, lines 15-35) with a paper support (column 4, lines 45-62) having a polymeric security layer comprising acrylate material (column 5, lines 5-15 and column 6, lines 7-15) which protects the paper layer.

Examiner maintains that neither Kaule nor Chiang teaches a filler substance in the protective layer and Chiang teaches an adhesive system having an acrylate system as the sole binder (column 6, lines 7-15). Applicant further argues Chiang does not disclose a surface coating layer which protects the paper layer, but discloses an adhesive layer. The adhesive layer functions as a protective layer as it keeps dirt and other environmental objects off the surface it is covering.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
L. Ferguson  
Patent Examiner  
AU 1774

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
